



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 2023  
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JAN 5 2001

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading questions 3, 13, 30, 38, and 39 of the morning section and questions 12 and 27 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner originally scored 68. On June 30, 2000, the Office mailed a Revised Notice of Result of April 12, 2000 Examination to revise petitioner's score to 69 because one point was awarded for question 27 in the afternoon session. On May 30, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no additional points on the Examination. No credit has been awarded for morning questions 3, 13, 30, 38, and 39 and afternoon question 12. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

The model answer is choice (E).

(E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (D) is correct therefore should be given credit. Petitioner did not present any argument why answer (D) is better than answer (E).

Petitioner’s argument has been fully considered but is not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (D). Answer (E) is correct because (B) and (D) are correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 13 reads as follows:

13. The specification of a patent application contains limited disclosure of using antisense technology in regulating three particular genes in *E. coli* cells. The specification contains three examples, each applying antisense technology to regulating one of the three particular genes in *E. coli* cells. Despite the limited disclosure, the specification states that the “the practices of this invention are generally applicable with respect to any organism containing genetic material

capable of being expressed such as bacteria, yeast, and other cellular organisms.” All of the original claims in the application are broadly directed to the application of antisense technology to any cell. No claim is directed to applying antisense technology to regulating any of the three particular genes in *E. coli* cells. The examiner rejects the claims under 35 U.S.C. § 112, first paragraph, for lack of enablement citing a publication that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell. The publication cites the inventor’s own articles (published after the application was filed) that include examples of the inventor’s own failures to control the expressions of other genes in *E. coli* and other types of cells. The rejection is:

- (A) appropriate. The claims are not commensurate in scope with the breadth of enablement inasmuch as the working examples in the application are narrow compared to the wide breadth of the claims, the unpredictability of the technology, the high quantity of experimentation needed to practice the technology in cells other than *E. coli*.
- (B) appropriate. The claims are not commensurate in scope with the breadth of the enablement inasmuch no information is provided proving the technology is safe when applied to animal consumption.
- (C) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the specification discloses that the “the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed.”
- (D) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the claims are original, and therefore are self-supporting.
- (E) inappropriate. The claims are commensurate in scope with the breadth of the enablement inasmuch as the inventor is not required to theorize or explain why the failures reported in the article occurred.

The model answer is choice (B).

13. ANSWER: (A). 35 U.S.C. § 112, first paragraph. *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (Fed. Cir. 1999). As stated in MPEP § 2164.01, “The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term ‘undue experimentation,’ it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” (B) is incorrect. As stated in MPEP 2107, part c. The requirement of 35 U.S.C. 101. for a “practical” utility or otherwise, is not a requirement that an applicant demonstrate that a utility is a safe or fully effective for human or animal consumption. *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). (C) is incorrect. The disclosure is inconsistent with published information. 35

U.S.C. § 112, first paragraph. (D) is incorrect. Enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims. The claims do not provide their own enablement. 35 U.S.C. § 112, first paragraph. (E) is incorrect. The lack of necessity to theorize or explain the failures does not alleviate the inventor from complying with 35 U.S.C. § 112, first paragraph by providing an enabling disclosure that is commensurate in scope with the claims.

Petitioner argues that the correct answer is (C). Petitioner contends that the fact pattern did not clearly indicate that "undue" or "high" experimentation was needed to practice the technology in cells other than *E. Coli*.

Petitioner's argument has been fully considered but is not persuasive. The question specifically states that "[t]he examiner citing a publication that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell." Accordingly, answer (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 30 reads as follows:

30. On February 8, 1999, you prepared and filed a patent application for Smith disclosing and claiming a new method for heating automobile windshields. The specification disclosed connecting a variable voltage source to a resistive heating element, connecting the heating element to the windshield, and adjusting the voltage of the voltage source to an effective amount. The specification stated certain advantages of heating automobile windshields by the invention's method, including protecting the internal structure of the glass from cracking, and defrosting the glass. The specification also fully disclosed guidelines adequately explaining that an effective amount of voltage to protect windshield glass from cracking was at least 0.5 volts, regardless of the outside temperature. The specification disclosed that an effective amount of voltage for defrosting windshields was at least 1.0 volt, regardless of the outside temperature. Claim 1 stated the following:

Claim 1. A method for heating an automobile windshield, comprising: connecting a variable voltage source to a resistive heating element; connecting the resistive heating element to the automobile windshield; and adjusting the voltage source to an effective amount of voltage.

You received a non-final Office action, dated February 4, 2000, rejecting claim 1 only under 35 U.S.C. § 112, second paragraph. The rejection stated that the use of the limitation, "an effective amount of voltage," rendered the claim indefinite. Which, if any, of the following actions, taken by you, comport with proper PTO rules and procedure, and will overcome the rejection?

- I. Filing an appeal with a brief, on August 3, 2000, arguing that the only remaining issue is the definiteness of claim 1, and that the claim is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
- II. Filing a reply on May 4, 2000, traversing the rejection on the grounds that claim 1 is not rendered indefinite by the use of the limitation, "an effective amount of voltage," since guidelines in the specification fully disclosed what "an effective voltage" would be.
- III. Filing a reply on May 4, 2000, amending the limitation, "an effective amount of voltage" to read, "an effective amount of voltage for defrosting the automobile windshield".

- (A) I.
- (B) II.
- (C) III.
- (D) II and III.
- (E) I, II, and III.

The model answer is choice is (C).

30. ANSWER: (C). MPEP § 2173.05(c), section III. (I) and (II) are incorrect since the phrase "an effective amount of voltage" has two different functions, i.e., to "protect windshield glass from cracking" and "for defrosting windshields." A claim has been held to be indefinite when the claim, as in this case, fails to state which of two disclosed functions is to be achieved. Thus, choices (A), (B), and (D) are incorrect. (C) is correct, since the amended claim would state the function that is to be achieved. (E) is incorrect since (C) is correct.

Petitioner argues that answer (D) is correct. Petitioner asserts that parts (II) and (III) are both correct answers making answer (D) the correct answer. Petitioner argues that (II) is correct because the "guidelines" in the specification fully disclosed what "an effective voltage would be."

Petitioner's arguments have been fully considered but they are not persuasive. Answer (D) includes choice II, which is incorrect because the phrase "an effective amount of voltage" has two different functions (i.e., to "protect windshield glass from cracking" and "for defrosting windshields"). A claim has been held to be indefinite when the claim, as in this case, fails to state

which of two disclosed functions is to be achieved. See MPEP § 2173.05(c), section III. The claim is unclear regarding which function is related to the phrase in the claim. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 38 reads as follows:

38. Inventor Charles patented a whirlwind device for defeathering poultry. Although the scope of the claims never changed substantively during original prosecution of the patent application, practitioner Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. After the patent issued, Charles realized that the claims were unduly narrow, and that the limitations argued by Roberts were not necessary to patentability of the invention. Accordingly, a timely application was made for a broadened reissue patent in which Charles sought claims without limitations relied upon by Roberts during original prosecution.

The new claims were properly supported by the original patent specification. Charles asserted in his reissue oath that there was an error in the original patent resulting from Roberts' failure to appreciate the full scope of the invention during original prosecution of the application. No supporting declaration from Roberts was submitted in the reissue application. Based on the foregoing facts and controlling law, which of the following statements is most accurate?

(A) Although the scope of the claims was not changed substantively during prosecution of the original patent, the recapture doctrine may preclude Charles from obtaining the requested reissue because of the repeated arguments made by practitioner Roberts.

(B) The recapture doctrine cannot apply because the claims were not amended substantively during original prosecution.

(C) The reissue application will not be given a filing date because no supporting declaration from practitioner Roberts was submitted.

(D) The doctrine of prosecution history estoppel prevents Charles from seeking by reissue an effective claim scope that is broader than the literal scope of the original claims

(E) The doctrine of late claiming prevents Charles from seeking an effective claim scope broader than the literal scope of the original claims.

The model answer is choice (A).

Selection (A) is the best answer as per *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998). (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. *Id.* (C) is wrong because, even if a declaration from Roberts is needed to help establish error, the reissue application will receive a filing date without an oath or declaration. See, e.g., 37 C.F.R. § 1.53(f), MPEP § 1403. (D) is not correct because, although the recapture rule and prosecution history estoppel are similar, prosecution history estoppel relates to efforts by a patentee to expand the effective scope of an issued patent through the doctrine of equivalents. *Hester*. (E) is incorrect because "late claiming" was long ago discredited, particularly in the context of reissue applications. See, e.g., *Correge v. Murphy*, 217 USPQ 753 (Fed. Cir. 1983); *Railroad Dynamics, Inc. v. A. Stucki Company*, 220 USPQ 929.

Petitioner argues that (B) is correct and (A) is incorrect based on the MPEP version available at the time of the examination. Petitioner contends that the MPEP available at the time of the examination did not discuss that arguments alone can cause surrender of subject matter. Petitioner concludes that answer (A) is incorrect and maintains that answer (B) is correct because of that omission from the MPEP.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the answer (B) is the best given the information in MPEP available, the instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. As explained in *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998), arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Accordingly, case law had modified the PTO rules of practice, rendering arguments alone as a cause for surrender of subject matter under recapture. The statement in



answer (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists \_\_\_\_\_

(A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.

(C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.

(E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent." (E) is incorrect because a (C) is correct.

Petitioner argues that (E) is correct and (C) is incorrect based on the MPEP version available at the time of the examination. Petitioner contends that the MPEP available at the time of the examination did not discuss that arguments alone can cause surrender of subject matter.

Petitioner concludes that answer (C) is incorrect and maintains that answer (E) is correct because of that omission from the MPEP.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the answer (E) is the best given the information in MPEP available at the time of the examination, the instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. As explained in *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998), arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Accordingly, case law had modified the PTO rules of practice, rendering arguments alone as a cause for surrender of subject matter under recapture. The statement suffix in answer (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:

12. Clem and Tine, while dating, invent a wedding ring programmed to chime on each wedding anniversary. Unfortunately, the romance did not last. Clem comes to you, a registered practitioner, and says that he now wants to file a patent application. Clem admits that it was partly Tine's idea. Clem further advises you that before the couple ended their relationship, Tine deceptively filed a patent application for the same wedding ring in her name alone, application No. 09/123456. Which of the following is the proper advice to give Clem in accordance with proper PTO practice and procedure?

- (A) File a patent application listing Clem as the sole inventor, and the appropriate fees. Since Tine has already filed an application for the same device as sole inventor, she cannot be

listed as a co-inventor in another application for the same device. An interference must be declared to determine proper inventorship.

- (B) File a patent application listing both Clem and Tine as coinventors, and the appropriate fees. If Tine refuses to sign the declaration, Clem has to file (i) a declaration signed by him naming himself and Tine as joint inventors, (ii) a petition, and (iii) the appropriate fees.
- (C) File a protest in the PTO (prior to the mailing of a notice of allowance in Tine's application) indicating the application serial number 09/123456 and informing the PTO that Clem is a coinventor.
- (D) Advise Clem that he could save money by allowing Tine to continue to prosecute her application and then, after the patent issues, he can sue her for half of the royalties.
- (E) (B) and (C).

The model answer is choice E.

Answer (E) is correct. Protests may be filed pursuant to 37 C.F.R. § 1.291. See MPEP § 1901.02. However, since protester may not be advised as to the outcome of protest, it behooves him to file a patent application listing both parties as co-inventors in accordance with 35 U.S.C. § 116. As to (D), since the inventorship is not correct, and was deceptively filed, the issued patent is likely to be declared invalid and he would not recover any royalties. (A) is incorrect because Clem is misrepresenting that he believes himself to be the sole inventor, whereas he has admitted that the invention "was partly Tine's idea." 37 C.F.R. § 1.56.

Petitioner selected answer C. Petitioner argues that choice C is the best answer because statement in answer (B) is not explicitly required by PTO practice and procedure.

Petitioner's arguments have been fully considered but they are not persuasive. While recommending filing a protest is a proper advice, the best answer is choice E that included both B and C because simply recommending the filing of a protest is insufficient to protect Clem's right. Protests may be filed pursuant to 37 C.F.R. § 1.291. See MPEP § 1901.02. Since a protester may not be advised as to the outcome of protest, it behooves him to file a patent application listing both parties as co-inventors in accordance with 35 U.S.C. § 116. Clem has no right in the application filed deceptively by Tine. Filing the patent application with the correct inventorship will protect Clem's right in the invention. No error in grading has been shown.

Petitioner's request for credit on this question is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

**ORDER**

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy